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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,501	04/06/2005	Pinchas Shalev	127/04241	6660
44909	7590	05/08/2006	EXAMINER	
WOLF, BLOCK, SCHORR & SOLIS-COHEN LLP 250 PARK AVENUE NEW YORK, NY 10177			PATEL, VINOD D	
			ART UNIT	PAPER NUMBER
			3742	

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/530,501

**Applicant(s)**

SHALEV ET AL.

**Examiner**

Vinod D. Patel

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED OFFICE ACTION**

### **INTRODUCTION**

1. This application/control number 10/530,501 has been examined. This is the first action on the merits of the claimed invention. The application has claims 1-30 pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 3 recites the limitation "the wire" in line 3. There is insufficient antecedent basis for this limitation in the claim.

For examination purpose, wire described in the claim 3 is treated as same as "an elongate element" recited in claim 1.

5. Claim 4 recites the limitation "springy post" in line 1. There is insufficient antecedent basis for this limitation in the claim.

For examination purpose, post described in the claim 4 are treated as same as recited in claim 3.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 01288291 A.

JP 01288291 A discloses an apparatus (10) comprising an elongate element (16) heated to a temperature capable of cutting hair; a vibrating structure, on which the elongate element is mounted and a housing in which the vibrating structure is mounted, vibrations of the vibrating structure causes the heat-generating element to pass two or more times over hair as the apparatus is moved slowly along a hair containing area of the skin.

From JP 01288291 A, translation, ("In a preferred embodiment of this invention, by applying pulse electric current or another vibration-generating mechanism between the electrode plated, the knife can be induced to vibrate, thus enabling an even an more efficient cutting operation" " Further, in this Practical example, a semiconductor pulse power 70 is installed that comprises power supply 60, pulse oscillator 62, and semiconductor element 64. As the pulse electric current 60 flows from the pulse power supply 60 between the first electrode plate 43 and second electrode plate 44 within the knife handle part 52 and the ceramics 46 being heated, vibrations occur throughout the knife including the electrode and ceramics, and due to the synergistic effect of the heating and vibration, the object is melted and removed, thus yielding the cutting effect."

Regarding the preamble recitation that the heating unit is "a hair cutting apparatus" such limitation merely recites the intended use of the apparatus and does not structurally limit the apparatus claimed. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable

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of performing the intended use, then it meets the claim. See In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). Moreover, "a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of [the apparatus] (emphasis in original). Ex nade Masham, 2 USPQ 2d 1647 (Bd. App. Pat. & Interf. 1987).

Here, JP 01288291 is inherently capable of cutting hair if so used, particularly in view of the knife's elevated temperatures that are commensurate with the hair cutting temperatures of the tool disclosed in the instant specification. Moreover, the recitations of hair and skin in the claims merely recite the workpiece to be heated (hair) and supporting surface for the work piece to be heated (skin). Accordingly, they do not limit the heating apparatus structure per se.

8. Claims 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase (1744525).

Chase discloses a tensioned heat-generating wire (11), comprising: positioning a wire on two separated posts (8,10), at least one of which is resilient in a direction along the wire axis; tensioning the wire in a direction and by an amount sufficient to deform the posts so that the positions of the wire on the posts toward each other (Fig. 2); and then fixing the wires in place (as shown in Fig. 2) so that they remain tensioned by the deformed post or posts, at least one of the posts is provided with a guide (Fig.2) for the wire and including: positioning the at least one wire guide; pulling at least one ends of the wire extending past the positions of the wires on the post in a direction having a zero or acute angle with the axis of the post, to bend the post toward the other post, the fixing comprises fixing the wire to its respective post while it is tensioned, the

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positioning occurs at the tip of the at least one post and the fixing occurs proximal to the tip (as shown in Fig. 2 and described in column 2, lines 59-100).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (1744525) in view of Hwang (US2003/0037793 A1).

With respect to claim 1, Chase discloses a hair cutting apparatus (Fig. 1-3) comprising: an elongate element (11) secured to arms (8) and (10) mounted to a base (5) heated to a temperature capable of cutting hair.

With respect to claim 3, Chase discloses the elongate element (11) is mounted between two posts (8, 10) separated by a distance, one or both of the posts comprising a resilient material, adapted to tension the wire.

With respect to claim 4, each springy post (8, 10) is relatively flexible in response to force applied in a first direction, and relatively non-flexible in response to force applied in a second direction as shown in the Figure 2 (column 2, lines 70-80).

With respect to claim 5, at least a portion of the posts (8, 10) comprises a guideway against which at least a portion of the wire is mounted as shown in the Figure 2.

With respect to claim 6, the posts (8, 10) are electrically conductive.

With respect to claim 7, the wire (11) is connected to the posts as shown in the Figure 2.

With respect to claim 8, Chase discloses an electrically conductive sockets on the structure adapted to receive the posts as shown in the Figure 2 (post 10 connected to base 5 in a socket, and post 8 connected to bar 6 at the end socket).

With respect to claim 9, Chase disclose two or more post stabilizers (base 5, and conductor bar 6), which limit the movement of the posts with respect to the housing in a direction perpendicular to an axis of the wire.

With respect to claim 1, Chase does not disclose a vibrating structure, on which the elongate element is mounted and a housing in which the vibrating structure is mounted.

Hwang discloses a vibrating type comb (10) comprising a comb shape plate (38) which vibrates by vibrator (30) mounted in a housing body (10), vibrations of the vibrating structure causes the comb to pass two or more times over hair as the apparatus is moved slowly along a hair containing area of the skin.

It would have been obvious to one of ordinary skill in the art at the time of invention to provide a vibrator as taught by Hwang for the hair cutting apparatus of Chase in order to straighten the hair prior to cutting to more precisely cut the hair using heat generating element.

With respect to claim 2, Vibrations of the vibrating structure causes the heat-generating element to pass two or more times over hair as the apparatus is moved slowly along a hair containing area of the skin is considered as a desired result. Desired result does not serve to distinguish over prior art hence the structure is disclosed. Cited art (Chase and Hwang) discloses the vibrator.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (1744525) in view of Hwang (US2003/0037793 A1) and further in view of Albert (US3925889).

Claim 10 differs from cited prior art (Chase and Hwang) in calling for an eccentric weight that causes the structure to vibrate as weight rotates.

Albert discloses an electric shaver comprising off-center weight mounted in the cutting head causing it to oscillate and mechanically feed all the hair in its path in to the comb as it passes over the surface to be shaved.

It would have been obvious to one of ordinary skill in the art at the time of invention to provide an eccentric weight that causes the structure to vibrates as weight rotates as taught by Albert for the modified device of Chase in order to oscillate and mechanically feed all the hair in its path in to the comb as it passes over the surface to be shaved.

13. Claims 11-13 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (1744525) in view of Hwang (US2003/0037793 A1) and in further view of Hattori (US6111222).

The cited prior art discloses all the claimed limitations except in calling for a motion detector that turns the vibrating structure on or off in response to movement of the wire along the area and the motion detector turns the vibrating structure on and off in response to a minimum



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speed, shutting off of the vibration, motion detector controlling the generation of heat on the elongate element, heat generating element off in response to a measurement of speed less than a predetermined speed, a heat generating element off in response to measurement of speed greater than a predetermined speed.

With respect to claim 18, the motion detector turns off heat generating element off in response to a speed greater than a predetermined speed as it is merely one should in the art would find it obvious to control the device based on the both on upper and lower operational speed since both high and low speed problematic with respect to precisely cutting hair.

Hattori (US 6,111,222) discloses a handheld electrically heated soldering tool whose tip is heated to a temperature of 300 to 800 C. See Fig. 1 and col. 3, lines 41-48. Although the tool is used for soldering, the tool's tip temperature is nonetheless sufficient to cut hair if so used. A motion detector 4 senses motion of the tool (and heat generator) relative to the workpiece being heated. A controller that is responsive to detected motion reduces heat to a lower level and ultimately interrupts the heater when the detected motion falls below a predetermined threshold. See col. 4, line 53 - col. 5, line 42. Such a motion- responsive control automatically reduces heat when the iron's movement is outside a desired range, thus increasing safety and reduces wasteful power consumption. See col. 1, lines 38-43. (Soldering irons and handheld thermal cutters constitute analogous art).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a motion-responsive control as taught by Hattori (US 6,111,222) for the modified device of Chase in order to automatically control the hair cutting device including desired control

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limitations thus increasing safety and comfort of the user and reduce wasteful power consumption.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (1744525) in view of Hwang (US2003/0037793 A1) and further in view of Hodges (US6032365).

The cited prior art discloses all the claimed limitations except in calling for a visual indication.

Hodges discloses a shaver comprising an indicator lights to indicate shaver is activated and/or in a charging mode.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an indicator lights as taught by Hodges for the modified device of Chase in order to indicate shaver is activated and/or in a charging mode.

15. Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (1744525) & Hwang (US2003/0037793 A1) in view of Kelman (US5606798).

The cited prior art (Chase and Hwang) discloses all the claimed limitations except in calling for a collecting the cut hair and moving the cut hair into a receptacle.

Kelman discloses a hair cutting apparatus (Fig. 2A, 3A) comprising a vacuum apparatus (24) for collecting hair in a detached unburnt condition.

It would have been obvious to provide a hair collecting vacuum apparatus as taught by Kelman for the modified hair cutting device of Chase in order to collect unburnt hair in a receptacle and keep user clean from unburnt hair on the clothes and body.

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The cited prior art does not recite method steps but discloses claimed structure; hence it would have been obvious to one of ordinary skill in the art to cut hair from an area of skin with vibrating heat generating element.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinod D. Patel whose telephone number is 571-272-4785. The examiner can normally be reached on 7.30 A.M. TO 4.00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans can be reached on 571-272-4777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP

 4/20/06  
Vinod Patel  
Patent Examiner  
Art Unit 3742